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10/573,024	08/12/2008	Mike Soumokil	07781.0270-00	4419

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SAP / FINNEGAN, HENDERSON LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER
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HAIDER, FAWAAD

ART UNIT	PAPER NUMBER
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3627

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,024	<b>Applicant(s)</b> SOU MOKIL, MIKE	
	<b>Examiner</b> FAWAAD HAIDER	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 30-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/22/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### ***DETAILED ACTION***

#### ***Status of Claims***

1. Examiner notes that three claim sets were filed on 3/22/06. For examination purposes claim set titled "Amendments To The Claims" (page 6) will be examined. Claims 1-29 were cancelled and claims 30-55 will be examined.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 3/26/2006 was considered. An initial copy of the IDS will be attached with this Office Action.

#### ***Claim Objections***

3. Claim 30 is objected to because of the following informalities: "... due within ap reselectable preselectable time..." should be changed to "... due within a reselectable preselectable time...". Appropriate correction is required.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 30-55 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 30-55 of copending Application No. 10/573,031. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of the applications claim a first and second state.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 30-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to a particular machine or apparatus (machine implemented) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the particular apparatus (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps.

Alternatively or to meet prong (2), the method step should positively recite identifying

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the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 30 fails prong (1) because the "tie" (e.g. "...computerized processing of invoices...") has to be in the body of the claim within a significant step. It does not suffice to have a "tie" to a particular machine in the preamble. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds (2003/0130937).

11. Regarding claim 55, Reynolds discloses a computer readable medium comprising instructions (see [0030]). The remaining limitations of claim 55 describe the

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instructions stored on the computer readable medium. As such, these limitations are directed towards nonfunctional descriptive material as the instructions themselves are claimed, rather than the method steps performed when the code stored on the computer readable medium is executed by a processor. It has been held that software without a required computer-readable medium-storing software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01 ) is merely nonfunctional descriptive material. Further, it has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

12. Claims 30-31 and 36-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinkle et al (7,254,288) in view of Baker et al (6,989,820) and Ahmed (EP 1,164,519).

Re Claims 30, 54, 55: Hinkle discloses comprising: selecting, from a plurality of invoices, such invoices which are due and the balance of which is larger than a preselectable first value (Hinkle col.4, lines 49-63 and Figure 4 elements 120 and 122).

However, Hinkle fails to disclose the following limitation. Meanwhile, Baker discloses assigning a first state to said selected invoices; and using the first state to

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control processing of the invoices (see Abstract, col.2, lines 35-67; col.3, lines 51-60; col.4, lines 44-57; col.5, lines 24-59; col.6, lines 12-23; line 46 through col.7, line 33; col.10, lines 41-65; Figures 5, 6A-B). From the teaching of Baker, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hinkle's invention with Baker's disclosure of assigning states in order to accurately track collection activity based on the target invoice parameters thereby facilitating optimal resource utilization and efficiency in processing invoices.

However, both Hinkle and Baker fail to disclose the following limitation. Meanwhile, Ahmed discloses a preselectable time or date (see [0083]). From the teaching of Ahmed, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Baker's and Hinkle's inventions with Ahmed's disclosure of a preselectable time or date in order to provide a more efficient means of managing large volumes of data without compromising efficiency.

Re Claim 31: Baker discloses further comprising: selecting, from said plurality of invoices, one or more invoices; and assigning a second state to said selected invoices (see Abstract, col.2, lines 35-67; col.3, lines 51-60; col.4, lines 44-57; col.5, lines 24-59; col.6, lines 12-23; line 46 through col.7, line 33; col.10, lines 41-65; Figures 5, 6A-B). From the teaching of Baker, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hinkle's invention with Baker's disclosure of assigning states in order to accurately track collection activity based on the target



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invoice parameters thereby facilitating optimal resource utilization and efficiency in processing invoices.

Re Claims 36, 38: Hinkle discloses further comprising: selecting, from said plurality of invoices, second invoices and third invoices (see Abstract; col.3, lines 27-54; col.4, lines 35-56; Figure 4, element 118; Figure 5). Baker discloses the balance of which is smaller than a preselectable second value and larger than a preselectable third value; and assigning a third state to the second invoices, the second value being smaller than or equal to the first value and the third value being smaller than the second value. Baker also discloses the balance of which is smaller than the third value; and assigning a fourth state to the third invoices (see Abstract, col.2, lines 35-67; col.3, lines 51-60; col.4, lines 44-57; col.5, lines 24-59; col.6, lines 12-23; line 46 through col.7, line 33; col.10, lines 41-65; Figures 5, 6A-B). From the teaching of Baker, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hinkle's invention with Baker's disclosure of assigning states in order to accurately track collection activity based on the target invoice parameters thereby facilitating optimal resource utilization and efficiency in processing invoices.

Re Claim 37: Hinkle discloses wherein the third state is a state of medium priority (see col.1, lines 27-40).

Re Claim 39: Hinkle discloses wherein the fourth state is a state of low priority (see col.1, lines 27-40).

Re Claim 40: Hinkle discloses wherein the preselectable first value is such that a preselectable percentage of the outstanding active debts or turnover of the company is controlled (see Abstract; col.1, lines 28-35; col.2, lines 20-28; Figure 1; Figure 4 element 114 and Figure 5; col.4, lines 45-50).

Re Claim 41: Hinkle discloses further comprising presenting the invoices of at least one of the first, second, third, and fourth state to a cash collector (see col.4, line 45-col.5, line 5; Figure 4, elements 116, 126, 132).

Re Claims 42-44: Hinkle discloses further comprising presenting the invoices having the first, second, third, or fourth at the latest of a presetable first period of time before the due date to the cash collector (see col.4, line 45- col.5, line 5; Figure 4 elements 116, 126, 132).

Re Claim 45: Hinkle discloses further comprising: controlling, by said cash collector, whether payments according to the invoices of at least one of the first and the second state have been made before, on, or after the due date, and, in case of a non-payment, presenting the non-payment invoices to a collecting service (see col.4, line 35-col.5, lines 6-30; Figure 4 elements 116, 126, 132).

Re Claim 46: Hinkle discloses wherein the second period of time is smaller than the first period of time and the third period of time is smaller than the second period of time (see col.4, lines 47-49).

Re Claim 47: Hinkle discloses further comprising dunning the customers of the accompanying due invoices (see Figure 4 elements 118, 126; col.4, lines 35-63; Figure 5, element 160).

Re Claim 48: Hinkle discloses wherein the collection service is a collection division of the company or an external collecting agency (see Figure 5 element 158).

Re Claim 49: Hinkle discloses further comprising: checking whether a non-payment is reasoned, and in case no, presenting such non-payment invoice to an external collecting agency (see col.4, line 35-col.5, line 30; Figure 4 element 126).

Re Claim 50: Hinkle discloses further comprising presenting the non-payment invoices to the collecting service as a to-do-list (see col.2, lines 8-19).

Re Claim 51: Hinkle discloses further comprising: receiving a request for a state change of an invoice from a customer; and changing the state of the invoice according to said request (see col.6, lines 10-20 and Figure 7, elements 180 and 184).

Re Claim 52: Hinkle discloses further comprising presenting the request to an internal clearing division before changing the state (see col.5, lines 15-30; Figure 5, element 158).

Re Claim 53: Hinkle discloses wherein the method is implemented as part of software for supporting business processes, the software comprising enterprise resource planning software (see col.13, lines 34-38).

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13. Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinkle et al (7,254,288) in view of Baker et al (6,989,820) and Ahmed (EP 1,164,519) and further in view of Underwood (6,718,535).

Hinkle, Baker, and Ahmed fail to disclose the following limitations.

Re Claims 32-35: Underwood discloses comprising representing at least one of said first state and second state by an entry into a respective data field (or by a first and second set of characters entered into one data field) of a data record comprising data of the respective invoice (see col.270, lines 27-33). Underwood also discloses wherein one or more of the plurality of invoices are invoices of special importance (see col.216, Figure 82). Underwood then discloses wherein said first and second states represent states of high priority (see col.216, Figure 82). From the teaching of Underwood, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hinkle's, Baker's, and Ahmed's inventions with Underwood's disclosure of priorities in order to use commonly used computer techniques such as tagging or to use commonly used computer models such as access.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fawaad Haider whose telephone number is 571-272-7178. The examiner can normally be reached on Monday-Friday 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fawaad Haider/

Examiner

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